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Washington, D.C. 20005-1202

In re application of
Richard G. HYATT, JR.
Application No.08/720,070
Filed: September 27, 1996
For: Electromechanical Cylinder Plug

CORRECTED DECISION ON PETITION

37 CFR 1.144

This decision on petition is corrected solely to the extent that it reflects the date of receipt of the original petition submitted by Applicant rather than the copy provided by facsimile at the request of the Office.

This is a decision on the petition received on April 27, 2000 wherein petitioner requests supervisory review of and relief from the examiner's final requirement to elect species (37 CFR 1.144).

The petition is **DISMISSED**.

An initial Requirement for Election of Species in the instant application was made in an Official Action mailed September 17, 1997. The requirement was made final in the Official Action mailed January 8, 1998 and the final requirement was repeated in the Supplemental Action mailed February 5, 1998.

Petitioner states, at page 3, "Applicant has traversed the requirement and believes that there is in fact no basis for continuing the insistence upon restriction." In support of the traverse, Applicant references MPEP §808, noting that the only issue which remains in contention with respect to §808 is the reason for insisting upon restriction between the independent or distinct inventions claimed. In further support of his position, Applicant references the current classifications of the Gokcebay '777 and Field et al. '307 patents of record in the instant application. Applicant then opines that the "mandatory search" required by Applicant's pending claims includes classes 70, 235, and 340. Finally, Applicant states "Accordingly, in view of the breath of the mandatory search, there is no basis for artificially dividing the several species disclosed and claimed in the instant application into separate applications."

It is noted that the Requirement held throughout prosecution of the instant application has been for Election of Species, as set forth in the Official action of September 17, 1997. With respect to species, MPEP §808.01(a) notes, in pertinent part, "There must be a patentable difference

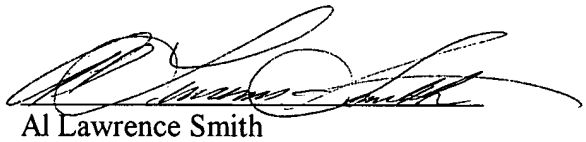
between the species as claimed. See MPEP §806.04(h)[1]. Since the claims are directed to independent inventions, restriction is proper pursuant to 37 CFR 1.121, and it is not necessary to show a separate status in the art or classification." Thus the argument to mandatory search, as advanced by Applicant, is not germane to the issue at hand.

Petitioner argues that "[I]n the instant application the Examiner and applicant agreed that there are several patentably distinct inventions disclosed." Applicant further asserts that the only remaining issue is the reason for insisting upon restriction between the claimed inventions. Inasmuch as Petitioner has agreed on the record that there are independent inventions present in the instant application, it is submitted that there is a *prima facie* burden in the examination of these separate, unrelated, independent, and patentably distinct inventions and as indicated by the field of search presented by these inventions by their inclusion in the same application. There is no requirement on the part of the examiner to search a plurality of separate, unrelated, independent, and patentably distinct inventions in one application. MPEP §809.02(a).

In summary, the instant petition pursuant to 37 CFR 1.144 is **DISMISSED** for the reasons set forth above.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.144".

This application will be forwarded to the Examiner for further action on the merits.



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[1] As set forth in MPEP §806.04(h), "Restriction should not be required if the species claimed are considered clearly unpatentable over each other."